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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,545	03/09/2001	Pijush K. Dewanjee	PU1182	8663

7590 11/17/2003

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EXAMINER	
LEE, EDMUND H	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 11/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,545	DEWANJEE, PIJUSH K.	
	Examiner	Art Unit	
	EDMUND H. LEE	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *20-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, drawn to a method of manufacturing a golf ball, classified in class 264, subclass 490.

II. Claims 20-29, drawn to a golf ball, classified in class 473, subclass 373.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as expanding the precursor by solvent instead of heat.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Michael Catania on 11/13/03 a provisional election was made without oral traverse to prosecute the invention of group I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 11-19 of U.S. Patent No. 6200512 (hereinafter USPN '512). Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN '512 teaches all of the claimed limitations as evident by claims 1-19.

7. Claim 6 is objected to because of the following informalities: it is dependent on itself. Appropriate correction is required.

8. Claim 2-4, 8-9, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a golf ball precursor product" (cl 2, lns 1-2) is indefinite because it is unclear whether or not it is related to the precursor product mentioned in ln 2 of cl 1. if they are the same, then it should be positively and clearly recited as such.

The phrase "a golf ball precursor product" (cl 3, ln 1) is indefinite because it is unclear whether or not it is related to the precursor product mentioned in ln 2 of cl 1. if they are the same, then it should be positively and clearly recited as such.

The phrase "a golf ball precursor product" (cl 4, ln 1) is indefinite because it is unclear whether or not it is related to the precursor product mentioned in ln 2 of cl 1. if they are the same, then it should be positively and clearly recited as such.

Clarification and/or correction is required.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-10 and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dewanjee et al (USPN 6200512). Dewanjee et al teach the claimed process as evident by claims 1-9 and 11-18 set forth at col 11, ln 1-col 12, ln 28.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

11. Claims 1-4,8-10,13-14 and 18-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Hwang (USPN 5879244). Hwang teaches the claimed process as evident by col 1, lns 20-25; col 2, lns 30-45; col 3, ln 63-col 4, ln 11; col 4, lns 47-58; col 5, lns 39-51; col 6, lns 27-30 and 55-61. Hwang also teaches using thermosetting polyurethane as the cover material (col 5, lns 3-9). It should be noted that Hwang teaches heating a golf ball precursor product such that the product undergoes volumetric thermal expansion (col 4, lns 6-26). It should also be noted that the instant claims are broad enough to read on applying a cover onto a golf ball precursor product that once was thermally expanded. The instant claims are not limited to applying a cover to a golf ball precursor product that is in an expanded state.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 5, 7, 11-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang (USPN 5879244). The above teachings of Hwang are incorporated hereinafter. Hwang does not teach the claimed heating parameters such as convection or microwave, temperature, and duration. These limitations are a mere obvious matter of choice dependent on molding equipment availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed heating parameters are well-known in the molding and golf ball art for their efficiency. Also, the claimed heating parameters are well-known in the molding art as important molding parameters and they would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to heat the golf ball precursor of Hwang according to the well-known claimed heating parameters in order to efficiently mold a golf ball having high quality.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pollitt et al (USPN 4056269) teach molding a golf ball and using a convection oven to heat a golf ball precursor product. JP 10-33716 teaches swelling a rubber core of a golf ball and then covering the core with a thermoset cover.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is

703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703.305.5493. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

EDMUND H. LEE
Primary Examiner 11/13/03
Art Unit 1732

EHL